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OFFICE OF PETITIONS

In re Patent No. 7,523,096	:	
Badros et al.	:	DECISION ON
Application No. 10/726,410	:	REQUEST FOR
Issue Date: April 21, 2009	:	RECONSIDERATION OF
Filed: December 3, 2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No.: 16113-1100001	:	UNDER 37 CFR § 1.705(d)
	:	and
	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed on June 16, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from four hundred and eight (408) to five hundred and seventy-four (574) days.

The request for reconsideration of patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

Patentee is given **THIRTY (30) DAYS OR ONE (1) MONTH**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised patent term adjustment of 474 days.

On April 21, 2009, the application matured into U.S. Patent No. 7,523,096, with a revised patent term adjustment of 408 days.

On June 16, 2009, Patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. Patentees request 100 days of additional patent term adjustment in accordance with the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under § 154(b)(1)(B) only if the delays "occur on the same calendar day." Patentees assert that a period of adjustment of 66 days should have been entered for Office delay in issuing the patent pursuant to 37 CFR 1.702(a)(4). In addition, Patentees maintain that the correct PTO delay for issuance beyond three years, pursuant to 37 CFR 1.703(b), from the filing is 100 days."

Regarding the assertion that the Office should have accorded a period of adjustment of 66 days for the delay associated with the issuance of this patent, the Office agrees. In this instance, a new notice of allowance was mailed July 15, 2008 and all outstanding requirements were met when the new issue fee transmittal was submitted on October 14, 2008. The conclusion that the controlling date in calculating the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(4) is the date of submission of the issue fee transmittal on October 14, 2008 in response to the new notice of allowance mailed July 15, 2008¹ is affirmed. Hence, the issue fee was received on October 14, 2008, and this patent did not issue until April 21, 2009, which is four months and 66 days after satisfaction of all outstanding requirements. It follows that a period of adjustment of 66 days should have been accorded, pursuant to 37 CFR 1.702(a)(4). The 66 day period of adjustment is now being entered.

Regarding the request for 100 days of additional patent term adjustment, the calculation of the patent term adjustment has been reconsidered and it is affirmed that the entry of such a period is not warranted. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

¹ Petition, page 2.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (June 15, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The Office has consistently taken the position that if an application is entitled to an adjustment under the three-year

pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A). The period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, there is an excluded period for the filing of a request for continued examination (RCE). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period beginning on the date of filing of the application, December 3, 2003 and ending on the date of filing of the request for continued examination, March 13, 2007. 496 days of adjustment for Office delay were accorded prior to the filing of the RCE. The 100 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 496 days attributable to grounds specified in § 1.702(a)(1). (66 days per this decision and pursuant to 37 CFR 1.702(a)(4) accrued after the filing of the RCE). Entry of the 496 days and the 100 days is neither permitted nor warranted. The greater period of 562 days is considered the actual number of days the issuance of the patent was delayed, including the 496 days as of the filing of the RCE and the 66 days subsequent to the filing of the RCE.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

In view of the additional period of adjustment of 66 days, the patent should have issued with a revised determination of patent term adjustment of 474 days ($496 + 66 - 88$).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a

certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 474 days.

Telephone inquiries specific to this matter should be directed to Paul Shanowski, Senior Attorney, at (571) 272-3225.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,523,096 B2

DATED : April 21, 2009

INVENTOR(S) : Badros et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 408 days

Delete the phrase "by 408" and insert – by 474 days--